

**REMARKS**

The application comprises claims 1-51, of which claims 1 and 24 are in independent form. Claims 1 and 24 are amended.

**Rejections under 35 USC 103**

The Examiner again rejects the claims for obviousness over the embodiment of Figs 12 to 15 in Nagle (WO02/059571) in view of the embodiments in Figs 1 and 2 of the same document.

Applicant in the previous response amended the claims to define that the frame is mounted in the holder such as to provide a clear approach to all six of the faces to enter for manipulation.

Applicant responds by amending the claim based on the passage at page 11 lines 21 and 22.

In the previous response applicant pointed out that Nagle Figs 12 to 15 teach a device held within a cage-like structure that appears to have six faces.

The specimen appears to be securely held within the cage.

The Fig. 2 embodiment teaches marking points of interest and the Fig. 1 embodiment teaches alignment of the points of interest with the container for tracking.

It was previously argued that, whilst the embodiment of Nagle could *not even* be said to have a clear approach for *viewing* from *any* of the faces of the structure, the present embodiments require a clear approach from *each* of the faces of the structure, which approach is an *entry* for *manipulation* of the specimen.

In the present amendment it is now added that the entry for manipulation is not limited by the structure.

In Nagle PCT, the embodiment of Fig. 12-15, finger like members cover most of the surface, and as shown below, the spaces between them are provided for interlocking with other finger like members so that no matter what size the members are, since the members of the other surface interlock, the two sets of interlocking members must be the same size and there is never more than 50% of the surface exposed.

Thus the Examiner's argument that it would be obvious to change the sizes of the members of Nagle to provide a clear approach cannot be accepted. Even if the members of Nagle were increased in size, or for that matter decreased, the need to interlock would still leave 50% of the surface covered by the members.

The finger-like members of Nagle are in fact designed and provided *only* in order to secure the specimen. Nagle is completely silent regarding any clear approach with regards to Figs. 12-15. Rather, finger like members are provided *only* to provide *mating* of the two mating pieces (202 204).

More particularly, in the embodiment of figs. 12-15, the width of the finger-like members, e.g. 220 & 222, has to be the same as that of the spacing between them, so that the two pieces (202 & 204) can mate. "finger-like members 220, 222 of sides 208,210 of first mating piece 202 mate with finger-like members 224 of side 212 of second mating piece 204 in an interlacing manner" (Nagle Page 19 lines 20 – 24). The interlacing is also clearly seen in the projections in fig. 14 &15, where it is apparent that no clear approach is possible. Thus, the area available for approach will be the same, ~50%, irrespective of the spacing between the finger-like members.

Examiner argues in response to the above that there are clear approaches of at least 1cm for direct manipulation, including insertion of a needle to draw a sample or insertion of a suture for identification on each side and each approach can be made larger with larger spacings as suggested by the specification. The Examiner has taken this point from the discussion of Nagle Fig. 6 on page 14 second paragraph.

In response, applicant has amended the claim to define that the clear approach is not limited by the structure.

In Nagle, since the interlocking constraint requires 50% of the surface to be covered, there is *considerable constraint on the approach to the specimen* from the *face of the structure*. In practice such a constraint would make a clear approach to a substantial fraction of the surface of the specimen *very difficult if not impossible*.

Contrary to the Examiner's claim, increasing or decreasing the spacing will not solve this problem in Nagle, since *no matter what the size of the members*, the interlocking constraint means that 50% of the surface is always concealed behind finger-like members.

The embodiment of fig. 5-11 cannot be modified to a form of that of fig. 12-15 without using *an equal width and separation*, as this is required by the principle of operation (mating) of "12-15", as stated in Nagle.

It would not be obvious to modify Nagle in any event since, in fact Nagle is very clear about the application contemplated, and the application contemplated does not entail any kind of physical manipulation. Rather, as discussed on page 18 last paragraph for the embodiment of Figs. 12 to 15 and page 15 first paragraph for the embodiment of Figs 5 – 11, the intention is radiographic examination. There is no mention anywhere in the discussion of the cited embodiments of Nagle of the insertion of a needle etc.

In fact the Examiner's attention is particularly drawn to the passage on page 8 lines 6 – 9 in the discussion of the cited Fig. 1 embodiment. Here it is clearly stated that the carrier 10 is made to be *cut* to allow access to the specimen. The present claims by contrast define a holder that allows access *without* being cut.

The Examiner mentions in the arguments that Nagle provides access for insertion of a suture for identification on each side. However Nagle page 9 first full paragraph merely teaches that the container *accommodates* a suture. There is no teaching of the suture being inserted as an approach to the sample when the sample is in situ. Likewise page 10 first full paragraph refers only to the initial positioning of the specimen and does not refer to any approach to the specimen in situ. Likewise page 11 second paragraph only refers to the positioning of the specimen before the structure is closed.

In summary, Nagle *only* teaches a structure for receiving and holding a tissue specimen that exposes *50%* of the surface of the specimen. The only clear approach unobstructed by the structure taught in Nagle is prior to assembly. Yet when the pieces are assembled and the structure has six faces, there is *no clear approach unobstructed by the structure at all*. Thus Nagle fails to teach

"the structure forming six faces, in a manner allowing a clear approach to *each* of said six faces *to enter for manipulation* of said specimen, and fixing the orientation of the tissue specimen, the *approach* to said specimen *at each face* for said entry for manipulation and fixing *not being limited by said structure*."

The same argument applies to claim 24, so that it too requires six faces and a clear approach *with entry from each face* for manipulation of the specimen.

Thus independent claims 1 and 24 are believed to be inventively distinguished over the prior art.

The remaining claims are believed to be allowable at least by virtue of being dependent on allowable main claims.

An early and favorable action is respectfully requested.

Respectfully submitted,

**/Jason H. Rosenblum/**

Jason H. Rosenblum  
Registration No. 56,437  
Telephone: 718.246.8482

Date: July 27, 2011

**Enclosures:**

- Petition for Extension (Three Months)